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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,548	06/10/2002	Reiner Mitzkus	GK-ZEI-3152/500343.20153	7566
7590 04/04/2005			EXAMINER	
GERALD H. KIEL REED SMITH LLP 599 LEXINGTON AVENUE, 29th FLOOR NEW YORK,, NY 10022			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,548

Applicant(s)

MITZKUS ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment of Jan. 05, 2005. It is noted that in the mentioned amendment, applicant has made amendments to the drawings and the claims 4-7. It is further note that applicant has provided a statement that the substitute specification filed on 6/10/2002 does not contain any new matter.

Drawings

2. The drawings contain three sheets of figures 1-3 were received on 1/5/2005. These drawings are objected by the Examiner for the following reason(s).

3. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See present specification in pages 1-2. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The substitute specification filed on 6/10/2002 has been entered because applicant has provided a statement that the substitute specification does not contain any new matter (see amendment, page 4, first paragraph).

5. The lengthy specification as provided in the substitute specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

6. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 7 is objected because it is unclear about the feature related to the so-called "filter modules" recited on line 2 of the claim. In other words, the feature "filter modules" appeared as a feature without a proper antecedent basis.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano et al (U.S. Patent No. 6,262,837) in view of the instructions provided in the LIS; Administrative Code for Therapeutic X-ray systems of less than one MeV, pages 1-6 and Olympus Microscopy Resource Center: Specialized Microscopy Techniques – Florescence Microscopy, pages 1-20..

Nagano et al disclose a fluorescent microscope having an illuminating system and a filter block for guiding light from the illuminating system to a sample and for

allowing the light from the sample to a receiving system. The filter block (7) comprises an excitation filter (4), a dichroic element (5) and a blocking filter (7) in the form of a wedge (see columns 6-7) and fig. 1. The only feature missing from the fluorescent microscope provided by Nagano et al is that they do not clearly disclose that the wedge of the blocking filter is marked with respect to its wedge angle for the purpose of orientation the wedge with respect to the light path. However, the use of a mark indicating the wedge angle of a wedge filter is known to one skilled in the art as can be seen in the instruction provided in the administrative Code for Therapeutic X-ray systems of less than one MeV when it requires that "each filter is marked as to its material of construction and its thickness or wedge angle for wedge filters; and it shall be possible for the operator to determine the presence or absence of each filter and the orientation of each wedge filter in the useful beam, either by display at the control panel or by direct observation" (see pages 1-2). Further, it is also noted that the use of an arrow or similar marking on the filter edge indicate the proper orientation in the light path is used by manufactures when they produce the filters as disclosed in the Olympus Microscopy Resource Center: Specialized Microscopy Techniques – Florescence Microscopy, pages 15. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the blocking filter used in the fluorescent microscope provided by Nagano et al by markings the wedge angle of the wedge blocking filter as suggested by the LIS; Administrative Code for Therapeutic X-ray systems of less than one MeV and Olympus

Microscopy Resource Center: Specialized Microscopy Techniques – Florescence Microscopy, for the purpose of providing the operator to determine the presence or absence of each filter and the orientation of each wedge filter in the useful beam.

9. Claims 5 and 7, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano et al (U.S. Patent No. 6,262,837) in view of the instructions provided in the LIS; Administrative Code for Therapeutic X-ray systems of less than one MeV, pages 1-6 and Olympus Microscopy Resource Center: Specialized Microscopy Techniques – Florescence Microscopy, pages 1-20 as applied to claim 4 above, and further in view of Hasegawa et al (U.S. Patent No. 6,219,180, of record).

The combined product as provided by Nagano et al and the administrative code and the Olympus documentation as provided in the paragraph (8) above does not clearly disclose that the filter comprises a module having a mark for the purpose of providing an alignment between the filter and the module and the light path. However, the use of a support or a module having a marker for the purpose of providing an alignment between an optical element and its support is known to one skilled in the art as can be seen in the system provided by Hasegawa et al. In particular, Hasegawa et al disclose a fluorescent microscope having an illuminating system for activating a fluorescent specimen. The illuminating system comprises a system having rotatable turret supporting a plurality of filters wherein each filter is provided with a marking. The turret also comprises a holder for supporting the filters wherein the support comprises a set of markings to shown

an observer the type of filter being used at a particular time. See columns 7-10 and figs. 13+. Thus, it would have been obvious to one skilled in the art as the time the invention was made to modify the combined product as provided by Nagano et al and the administrative code and the Olympus documentation by using a support or a module having markings as suggested by Hasegawa et al for the purpose of providing a consistence or a reference for arrangement of the filters to make the alignment of each of the filters with respect to its supporting holder faster and more accuracy.

Response to Arguments

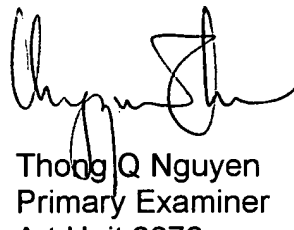
10. Applicant's arguments with respect to claims 4-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
